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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,679	12/10/2001	Takeshi Araki	401502	1583
23548	7590	08/12/2003		
LEYDIG VOIT & MAYER, LTD 700 THIRTEENTH ST. NW SUITE 300 WASHINGTON, DC 20005-3960			EXAMINER	
			SHEEHAN, JOHN P	
			ART UNIT	PAPER NUMBER
			1742	7

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/006,679	ARAKI ET AL.+
	Examiner	Art Unit
	John P. Sheehan	1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 May 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3 is/are pending in the application.

4a) Of the above claim(s) 3 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 and 2 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Election/Restrictions***

1. This application contains claim 3 drawn to an invention nonelected with traverse in Paper No. 4. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Araki et al. (Araki, US Patent No. 5,676,998).

Araki teaches a thin film magnet having a composition that overlaps the alloy composition recited in applicants' claims (column 2, lines 47 to 55) and specific example

alloys having a composition encompassed by applicants' claims (see Araki's Tables 5 to 7). Araki teaches that the main phase of the alloy is Nd<sub>2</sub>Fe<sub>14</sub>B (column 2, lines 50 to 51). Araki teaches that the C-axis of the alloy film is oriented normal to the film plane (column 6, lines 25 to 27). Araki teaches that the disclosed thin film is made by physical vapor deposition on a substrate while heating the substrate (column 2, lines 60 to 67). Araki teaches specific examples wherein the alloy composition and the substrate temperature are encompassed by the substrate temperatures disclosed in the instant application and the alloy composition recited in the instant claims (for example, compare Table 2 of the instant application to the compositions and substrate temperatures in Araki's Table 7).

The claims and the Araki differ in that Araki is silent with respect to the presence of an amorphous phase, the amorphous phase isolating the Nd<sub>2</sub>Fe<sub>14</sub>B phase and the process limitation that the temperature of the front side of the substrate is controlled within  $\pm 2^{\circ}\text{C}$ .

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the specific example alloy compositions taught by Araki are encompassed by the instant claims and are made by the same process, including heating the substrate to the same temperature as disclosed in the instant application and therefore one of ordinary skill in the art would expect that the products taught by Araki would be the same as applicant's claimed product, including the presence of an amorphous phase and the amorphous phase isolating the Nd<sub>2</sub>Fe<sub>14</sub>B phase.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

With respect to the process limitation that the temperature of the front side of the substrate is controlled within  $\pm 2^{\circ}\text{C}$  it is the Examiner's position that a process limitation recited in the instant product by process claims does not necessarily lend patentability to the claimed product, MPEP 2113.

### ***Response to Arguments***

4. Applicant's arguments filed May 18, 2003 have been fully considered but they are not persuasive.

Applicants argue that the control of the substrate temperature within a range of  $\pm 2^{\circ}\text{C}$  recited in the instant product by process claims results in an alloy structure that is different from the alloy structure of Araki's alloy. The Examiner is not persuaded.

Applicants have not presented any probative evidence to support their position.

Applicants state that Araki's alloy has the structure shown in Figure 3 of the instant application. However, Figure 3 is not a photomicrograph but rather is a schematic drawing of a crystal structure with no disclosed nexus in the application as filed to Araki's alloy. Thus, in the absence of any evidence, applicants' arguments are

considered to be unsubstantiated allegations. "It is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements in the specification do not suffice." *In re Deblauwe*, 222 USPQ 191, 196 (Fed. Cir. 1984). Mere lawyer's arguments and conclusory statements in the specification, unsupported by objective evidence, are insufficient to establish unexpected results." *In re Wood, Whittaker, Stirling and Ohta*, 199 USPQ 137, 140 (CCPA 1978).

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

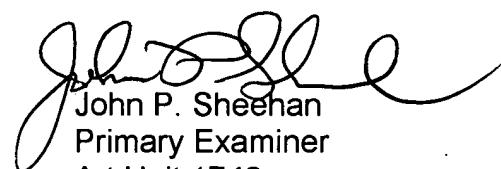
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



John P. Sheehan  
Primary Examiner  
Art Unit 1742

jps  
August 6, 2003